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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,919	02/27/2004	Geoffery H. Dreyer	435565-405	7488

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EXAMINER

ALPERT, JAMES M

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/788,919	Applicant(s) DREYER ET AL.	
	Examiner James Alpert	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following communication is in response to Applicant's remarks filed 15 December 2005.

Status of Claims

No claims have been amended, nor are any claims canceled. In addition, no new claims have been presented, so therefore, Claims 1-5 are currently pending as originally filed.

Administrative Note

Applicants' IDS filed 27 February 2004 indicates that Applicants have submitted four (4) non-patent literature documents, comprising Wells Fargo Time Saver Solicitations, but the Examiner has not been able to find these in the electronic file wrapper. The Examiner respectfully requests verification that these documents have been submitted by Applicants.

Response to Arguments

Applicant's arguments filed 15 December 2005 have been fully considered, in an effort to determine patentability. In addition, a series of telephonic conversations have been held between the Examiner and Applicants' representative, Jason Hunt, Registration #53048, over the few days between November 21 and November 23, 2006. The subject matter of the discussions was whether the claims in the instant application could be amended in such a way that, in the Examiner's opinion, the claims would be sufficiently differentiated from the teachings of the prior art, including Lewis, U.S. Patent Application Publication #20020029194 and Brody, U.S. Patent Application Publication

#20020077964. No agreement was finally reached as to possible amendments, and thus this action is presented. Please note, however, that in an effort to advance this application to issue, the current Action is non-final so as to afford Applicants' an additional opportunity to amend.

With regard to the rejections under 35 U.S.C. §101, #1, Applicants' argument are not persuasive, and these rejections are maintained, as discussed below. **With regard to the rejections under 35 U.S.C. §101, #2**, Applicants' argument are persuasive, and these rejections are withdrawn. **With regard to the rejections under 35 U.S.C. §103, as to Claim 1**, Applicants' arguments are persuasive, however new grounds of rejection are presented below. **As to Claims 2-5**, Applicants arguments are not persuasive, and these claims remain rejected as in the previous Office Action, and Applicants' request for allowance is respectfully declined.

Claim Rejections - 35 USC § 101

The text of 35 U.S.C. §101, which is not included in this action, can be found in a prior Office action. Claim 1 stands rejected under §101 as being directed to non-statutory subject matter. Applicants argue that the Interim Guidelines compel a finding that a "closing package" is a thing or product, within the purview of the statute. The Examiner would point out that the Guidelines, in fact, offer contrary instruction, indicating that legal agreements are *per se* non-statutory. The Guidelines use an insurance policy as an example, and point out that a claim to an insurance policy, as contrasted with the method of creating the characteristics of such a policy, would not be patent eligible subject matter.

The Examiner treats the closing package as a set of documents used to form a legally binding agreement for the financing and transfer of property in a real estate transaction. This is consistent with the ordinary meaning ascribed to a "closing package" by one of ordinary skill in the art. As such, a closing package is *per se* non-statutory.

Claim Rejections - 35 USC § 103

The text of 35 U.S.C. §103, which is not included in this action, can be found in a prior Office action. Claim 1 is rejected as being unpatentable over Lewis, and Claims 2-5 are rejected as being unpatentable over Brody in view of Lewis.

With regard to Claim 1, Lewis teaches a closing package comprising:

at least one document comprising a plurality of acknowledgements, agreements, and disclosures accommodating variations in legal requirements relating to said closing documents. (Claims 1, 23)

providing guidance to said customer for completing and executing said closing documents comprising steps for customer's guidance and steps notary's guidance in said completion and execution of said closing documents; (See Paragraphs 96,103, describing closing transactions rules and a documents rules, which govern what document are presented to a user, including the customer, as well as to how the documents must be executed. See Paragraph,125, describing the steps necessary for notarization of documents when required.)

Lewis does not expressly teach that the guidance and steps are provided in the form of a checklist. However, this can be considered a matter of design choice. That is to say, documents with annotated directions, narrative paragraphs, and checklists are all possible means for communicating instructions to a user completing documents. Further, these types of instructions are well known in the financial arts. An easy example that comes to mind is the guidance that is provided in filling out IRS forms,

which is reasonably pertinent to the particular problem solved by Applicants, namely successfully executing a complex legal document. Thus it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to modify the teachings of Lewis, related to providing a closing package disclosing legal requirements, to include a checklist for completing execution by the customer. A motivation for such a combination can be found within the general knowledge available to one of ordinary skill in the art, and is simply to decrease closings costs by reducing errors. While the Examiner likely expects Applicants to maintain that this motivation is made in impermissible hindsight, it is important to realize that in the financial arts, such observations are obvious due to the level of skill required in the art. That is to say, practitioners in the financial arts are all keenly aware that costs savings are universally sought.

Applicants begin to argue in Claim 1 the idea that the traditional parties such as lawyers, title agents, etc retain their roles in the system of Lewis. The Examiner will address this briefly, and point out that while roles may be retained in Lewis, there is clearly an absence of a meeting, as claimed by Applicants. Other than the absence of a meeting, the claims do not present any limitation that requires other parties refrain from participating in the transaction.

With regard to Claims 2-3, Brody teaches a method comprising:

pre-approving a customer for refinancing of a mortgage loan;
(Paras. 11-13 and Para. 68, describing pre-approved mortgages)

sending an offer for said refinancing to said customer
(Para. 15)

Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if anything, to the claimed structure or acts and thus do not serve as a limitation on the claims to distinguish over the prior art. For example, language directed to an intended use of dispensing popcorn in a claim for a product did not result in a structural or functional difference with respect to prior art and were held not to serve as a limitation on the claim. See In re Schreiber, 44 USPQ2d 1429 (CAFC 1997).

Thus, a limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See In re Gulack, 217 USPQ 401 (CAFC 1983), Ex parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and In re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Brody does not expressly teach that the offer expressly comprises:

materials setting forth terms of said refinanced mortgage loan, at least one of said terms of said refinanced mortgage loan comprising a specific, locked interest rate;

materials providing pre-acceptance disclosures and conditions, and

instructions describing how said customer may accept said offer;

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. That is to say, the exact type of material included in the offer does not effect the step of providing an offer. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the above described materials, because the type of material does not functionally relate to the steps in the method claimed and does not patentably distinguish the claimed invention.

Applicants have not expressly traversed the notion that this language is descriptive material, other than to suggest that each step comprises "a part of the overall streamlined process." However it is clear that the materials making up both the offer and the closing package are not related, functionally, to the steps in the claim. Applicants do offer a variety of different reasons why a 103 rejection is in their opinion, insufficient, and the examiner will address these arguments in due course.

Continuing, Brody teaches the method further comprising:
receiving an indication of acceptance of said offer from said customer; and
(Para. 16)

Brody does not specifically teach the step comprising:
sending a closing package to said customer to be executed by said customer, said closing package.

However, in an analogous application, Lewis teaches this limitation at (Claim 1 and Claim 23), which describes presenting documents to the offeree. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Brody, relating to pre-approving, offering and accepting mortgage agreements, with the teachings of Lewis, relating to providing a closing package. The motivation for such a combination would be to help ease problems related to multiple inquiries on a credit report, in that the process is a one step process, rather than several steps. Further, there would be benefits to streamlining the process down to a simpler form.

Brody nor Lewis expressly disclose that the closing package comprises:
at least one document comprising
instructions providing guidance to said customer for completing and executing said closing documents in the absence of a meeting, said instructions comprising
a checklist of steps for said customer's guidance and steps for a notary's guidance in said completion and execution of said closing documents, and
at least one document comprising a plurality of acknowledgements, agreements, and disclosures accommodating variations in legal requirements relating to said closing documents,
said execution of said closing documents by said customer creating a refinancing loan agreement.

However, as with the above limitations, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. That is to say, the exact type of material included in the closing package does not effect the step of providing a closing package. As well, the structure of the claims does

positively recite that a refinancing agreement is actually created. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the above described closing documents, because the type of material does not functionally relate to the steps in the method claimed and does not patentably distinguish the claimed invention.

Applicants further advance several arguments in an attempt to demonstrate a failure of the Office to present a *prima facie* case of obviousness under §103. The examiner will address each argument. Initially, on page 7 of the remarks, Applicants argue that hindsight reasoning is prohibited, and that the Examiner is piecing together Applicants' invention. The Examiner disagrees. In order to determine what is taught or known in the prior art, the Examiner must first determine precisely what is claimed in the application. Once that analysis is complete, the Examiner then seeks to determine what are the teachings of the prior art. If the elements of the claim are taught or known in the art, but with more than one reference, the examiner must then determine whether, without the benefit of Applicants' disclosure, it would have been obvious to combine or modify references. Thus, it is imperative that the Examiner "construct" claims. In the instant case, the Examiner has concluded that each element of Applicants' claims are either taught in a reference or well known in the art. The question thus turns to whether the elements as taught or known would have been combined by one of ordinary skill in the art. As to hindsight, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time

the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The key issue for the Examiner is to critically assess whether the motivation to combine is based on knowledge generally available to practitioners in the art. In the instant application, the motivational statements would be known and unambiguous to those practicing in the art, and typically involves decreasing administrative overhead, as well as decreasing the time involved in closing a real estate transaction. The examiner is satisfied that there is proper motivation to combine references.

Applicants argue, at pages 8-9, that Brody does not teach pre-approval in the same manner as Applicants. This may or may not be true, however, this issue is not necessarily relevant in that it is not required that Brody teach the same invention as disclosed in Applicants' specification. Rather, all that is required is that the teachings of Brody are directed to the claimed invention. Applicants' claims themselves do not recite a high degree of particularity of what is entailed in a "pre-approval". As such, and given the non-functional language in claims, Brody satisfactorily teaches "pre-approving" a customer and "sending" an offer.

At pages 9-11 of their remarks, Applicants also drift into an argument that can be boiled down to as something akin to 'our invention doesn't involve lawyers and other 3rd parties' whereas the teachings of Lewis and Brody do. While there may be merit to this assertion, as the invention is presently claimed, there is not necessarily a requirement that 3rd parties be excluded from the process. While a physical meeting is specifically

addressed, there is no such restriction that other parties to the transaction must be removed. Thus, the references adequately address the limitations of the claims as presently presented.

As stated in the previous Office Action, **and with regard to Claim 4**, the only further distinction between this claim and previous claims is found in the descriptive material, and comprises a specification that as part of the materials included in the offer, that there be one term comprising an interest rate and a term length. Therefore, this claim is rejected under a similar analysis as Claims 2-3.

As stated in the previous Office Action, **and with regard to Claim 5**, the only distinction between this claim and Claim 2 is that a request for financing initiates the refinancing process rather than a pre-approval step. However, this distinction is old and well known in the art, in that a request for a loan or mortgages, electronically or otherwise, is very, very common. Further, Brody actually teaches this claim in that potential approvees are allowed to opt in or out of the pre-approval process, allowing the consumer to initiate the process. See (Figure #5 and Page 10-11, Para. 83). Brody anticipates the distinction in the claim, and the claim is rejected under a similar analysis as Claim 2.

Conclusion

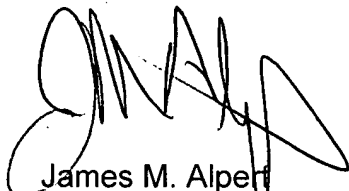
THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, James Trammel, can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197. Respectfully presented,



James M. Alpert
November 24, 2006



ELLA COLBERT
PRIMARY EXAMINER